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09/735,697	12/12/2000	Noel Lee	P1230	6750

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EXAMINER
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DEBERADINIS, ROBERT L

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte NOEL LEE

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Application 09/735,697  
Technology Center 2800

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Mailed: January 22, 2009

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Before PAMELA S. BENNETT, *Review Team Paralegal*.  
BENNETT, *Review Team Paralegal*.

ORDER RETURNING UNDOCKETED APPEAL

This application was received electronically at the Board of Patent Appeals and Interferences on March 6, 2008. A review of the application revealed that it is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner to address the following matters requiring attention prior to docketing.

APPEAL BRIEF

According to page 7 of the Corrected Appeal Brief filed March 9, 2006, an Appeal Brief was filed on December 19, 2005. However, that paper appears to be missing from the record. A copy of this Appeal Brief should be obtained and scanned into the Image File Wrapper (IFW) to complete the record.

CORRECTED APPEAL BRIEF, EVIDENCE APPENDIX

An in-depth review of the corrected Appeal Brief filed March 9, 2006 indicates that the following section is missing and/or is not complete:

1) “Evidence Appendix”.

37 CFR § 41.37 (2005) states:

(ix) *Evidence appendix*. An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

The Appeal Brief filed March 9, 2006, is not compliant because:

1. copies of the § 1.131(a) and § 1.132 Declarations of Noel Lee, Karen Johnson, and Albert Mehrabian filed on December 20, 2000, discussed on pages 9 and 15, do not appear in the “Evidence Appendix;” and

2. copies of the articles by Leonard Wiener, entitled “SmarterStrip,” U.S. News & World Report, published May 5, 1997, and as an anonymous

article, entitled “Designer Surge Protectors Debut from Kensington,” Twice, published April 7, 1997, discussed on page 12, do not appear in the “Evidence Appendix.”

Further, it is noted that the “Evidence Appendix” in the Appeal Brief filed March 9 2006, ends on page 43, but the “Related Proceedings Appendix” in the Supplemental Appeal Brief filed April 27, 2006, begins on page 52. Clarification is required regarding the status of pages 44-51.<sup>1</sup>

An entire new brief need not, and should not, be filed. Rather, a paper providing a revised “Evidence Appendix” as required by 37 CFR 41.37(c)(1)(ix) will suffice. Failure to timely respond to the Office’s requirement will result in dismissal of the appeal. See MPEP § 1215.04 and §711.02(b). Correction is required.

### CONCLUSION

Accordingly, it is

ORDERED that the application is returned to the Examiner:

- 1) to obtain a copy of the Appeal Brief filed December 19, 2005, and have a copy of same scanned into the IFW;
- 2) to hold the Appeal Brief filed March 9 2006, defective;
- 3) to notify Appellant to file a paper which corrects the “Evidence Appendix” by providing copies of the cited declarations and references as identified above;

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<sup>1</sup> It is noted that with the exception of the “Comparative Drawings” relating to the present invention, the remainder of the items under this heading listed on page 35 were omitted from the “Evidence Appendix.”

4) for clarification regarding the status of pages 44-51 of the “Evidence Appendix” appearing in the Appeal Brief filed March 9, 2006; and

5) for such further action as may be appropriate.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

PSB

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